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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/708,047 | 02/05/2004 | Wen-Huang Liu | KYCP0014USA | 2046 |
| 27765 | 7590 | 12/07/2005 | EXAMINER | |
| NORTH AMERICA INTELLECTUAL PROPERTY CORPORATION P.O. BOX 506 MERRIFIELD, VA 22116 | | | PRENTY, MARK V | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2822 | |

DATE MAILED: 12/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/708,047

Applicant(s)

LIU ET AL.

Examiner

MARK PRENTY

Art Unit

2822

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 16-26 is/are rejected.
- 7) ☒ Claim(s) 2-15 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

This Office Action is in response to the response filed on November 3, 2005.

Claims 16-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Specifically, claims 16-26 are indefinite in reciting, "...or other substitute materials."

Claims 1, 16 and 18 are rejected under 35 U.S.C. 102(e) as being anticipated by United States Patent 6,645,783 to Brunner et al. (Brunner).

With respect to independent claim 1, Brunner discloses a light-emitting device with compound substrate comprising (see the entire patent, particularly the Fig. 1 disclosure): a compound substrate comprising a high thermal conductive layer 13 and a substrate 4 disposed around the high thermal conductive layer (see column 5, lines 14-15); an adhesive layer formed on the compound substrate (see column 5, lines 9-11); and a light-emitting stack layer 1 formed on the adhesive layer (see column 4, lines 59-64 and column 5, lines 9-11).

Claim 1 is thus rejected under 35 U.S.C. 102(e) as being anticipated by Brunner.

With respect to dependent claim 16, Brunner's high thermal conductive layer 13 comprises copper (Cu) (see column 5, lines 14-15).

Claim 16 is thus rejected under 35 U.S.C. 102(e) as being anticipated by Brunner.

With respect to dependent claim 18, Brunner's substrate preferably comprises plastic (see column 5, lines 63-64).

Claim 18, at least insofar as understood, is thus rejected under 35 U.S.C. 102(e) as being anticipated by Brunner.

Claim 24, at least insofar as understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent 6,645,783 to Brunner et al. (Brunner) together with the admitted Prior Art (see the specification at paragraphs [0003-0005]).

Claim 24 depends on independent claim 1, which is rejected under 35 U.S.C. 102(e) as being anticipated by Brunner (see above). The above explanation of the rejection of independent claim 1 under 35 U.S.C. 102(e) as being anticipated by Brunner is hereby incorporated by reference into this rejection of dependent claim 24 under 35 U.S.C. 103(a) as being unpatentable over Brunner together with the admitted Prior Art.

The difference, therefore, between claim 24 and Brunner is claim 24's light-emitting stack comprises AlGaInP, for example, while Brunner does not disclose its light-emitting stack's composition.

The admitted Prior Art teaches that light-emitting devices conventionally comprise AlGaInP (see the specification at paragraphs [0003-0005]).

It would have been obvious to one skilled in this art to form Brunner's light-emitting device 1 of AlGaInP because the admitted Prior Art teaches that light-emitting devices are conventionally formed of AlGaInP.

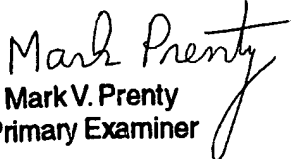
Claim 24, at least insofar as understood, is thus rejected under 35 U.S.C. 103(a) as being obvious over Brunner together with the admitted Prior Art.

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Claims 2-15 are objected to as being dependent upon a rejected base claim, but would be allowable over the prior art of record if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The applicant's arguments are moot in view of the new grounds of rejection.

Registered practitioners can telephone the examiner at (571) 272-1843. Any voicemail message left for the examiner must include the name and registration number of the registered practitioner calling, and the Application/Control (Serial) Number. Technology Center 2800's general telephone number is (571) 272-2800.


Mark V. Prenty
Primary Examiner